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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,425	09/26/2003	Arthur Coello	1.240:03	8437

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EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,425

Applicant(s)

COELLO ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) 12,13,52,53 and 55-72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11,14-51 and 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-72 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 032604.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-58, drawn to a temporary aqueous aerosol paint composition, classified in class 106, subclass 31.01.
 - II. Claims 59-72, drawn to a method for preparing an aqueous paint component, classified in class 53, subclass 75.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process not involving the intricacies of the process of Group II such as charging an initial amount of solvent and/or the various mixing cycles.
3. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

SPECIES OF PIGMENT

- a. Fluorescent colored pigment (claims 10, 11, 52 and 54-57).
 - i. The fluorescent pigment of claim 52.
 - ii. The fluorescent pigment of claim 54.
 - iii. The fluorescent pigment of claim 55.
 - iv. The fluorescent pigment of claim 56.
 - v. The fluorescent pigment of claim 57.
- b. White pigment (claims 12 and 58).
- c. Multiple pigments (claims 13 and 53).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species or subspecies for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. During a telephone conversation with John Fulton, Jr. on 9/14/05, a provisional election was made with traverse to prosecute the invention of Group I, species a, subspecies ii, claims 1-11, 14-51 and 54. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12, 13, 52, 53 and 55-72 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 23-33, 35-51 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claims 23-33, 35-51 and 54, the term "generally" used throughout the claims render the claims indefinite because it is unclear whether the limitations following the phrase "generally about" are necessary parts of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-2, 8, 16-18, 21-29 and 32-34 are rejected under 35 U.S.C. 102(b) as being anticipate by Swartz (USPN 5,250,599) or Jamasbi (USPN 5,451,627).

Each of Swartz (col. 5, lines 3-66) and Jamasbi (col. 5, line 25 to col. 6, line 20) teach aqueous aerosol paint compositions comprising the claimed amounts of an aqueous solvent, a polymeric resin, pigment, filler compounds, a dispersant/surfactant, an anti-foaming agent, an aqueous propellant component and other conventional additives.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

13. Claims 1-2, 8, 10, 11, 16-18, 21-29 and 32-34 are rejected under 35 U.S.C. 102(b) as being anticipate by Suk (USPN 4,450,253).

In col. 2, lines 35-55, col. 7, lines 11-49 and Examples, Suk, teaches aqueous aerosol paint compositions comprising the claimed amounts of an aqueous solvent, a polymeric resin, colored pigment, filler compounds, a dispersant/surfactant, an anti-foaming agent, an aqueous propellant component and other conventional additives

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 3-7, 9, 14, 15, 19, 20, 30, 31, 35-51 and 54 are rejected under 35

U.S.C. 103(a) as being unpatentable over Swartz, Jamasbi or Suk.

Although Swartz, Jamasbi or Suk, above, do not disclose conventional aerosol paint additives such as a bactericide, a light stabilizer, the specific fillers claimed and polyvinyl acetate as the polymeric resin, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to include these conventional additives to the aerosol paint compositions. The applicant has not shown unexpected results from including these additives in the aqueous aerosol paint compositions.

Further, regarding the filtered water, a pure composition is unpatentable over an impure one if the utility is the same (See *In re Crosley* 72 USPQ 499 and *In re Merz* 1938 CD 728).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCE KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER

A handwritten signature in black ink, consisting of stylized, overlapping loops and a long horizontal stroke at the bottom.